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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,645	11/19/2001	Michiel Adrianus Henricus Van Der Aa	APV31511	9670

7590 05/23/2003

Stevens David Miller & Mosher  
1615 L Street N W Suite 850  
Washington, DC 20036

EXAMINER
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GOETZ, JOHN S

ART UNIT	PAPER NUMBER
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3725

12

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

<b>Office Action Summary</b>	Application No. 09/914,645	Applicant(s) VAN DER AA ET AL.	
	Examiner John S. Goetz	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings/Specification***

1. The specification is objected to under 37 C.F.R. 1.71 as not clearly describing the subject matter of the invention.
2. The specification is fatally defective. Specifically, a preferred embodiment is not disclosed in the specification or in the drawing. Additionally, the subject matter disclosed in the specification and the drawing is not described in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It appears that any corrective amendment would contain new matter.
3. Evidence of non-enablement is seen in the two prior art definitions of “entry angle.” The first is found in EP 0,298,560, as cited by applicant, where the datum from which the angle is measured runs along the longitudinal length of the forming surface (see Fig. 2). A second definition is found in McHenry et al. (6,098,829 – hereinafter McHenry ‘829), where the datum from which the angle is measured runs orthogonal to the longitudinal length of the forming surface. Thus, the term “entry angle,” without more, is not enabling to one of skill in the art and any clarification of “entry angle” would contain new matter.
4. Additionally, the drawings are objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. As for example, the following features occur in the claims but are not included in any drawing:
  - i. a plurality of wall-ironing tools, with a plurality of forming surfaces;
  - ii. entry angle of said forming surfaces;
  - iii. starting, intermediate and subsequent zones;

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- iv. land zone;
- v. a smooth change in the entry angle over the length of the forming surface;
- vi. transitions between zones in the shape of an arc;
- vii. a plurality of wall-ironing rings;
- viii. main zone;
- ix. a strip or wire wound around the ring under stress.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-12 and 17-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the reasons stated above.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6, 9-12, 18-20, 22, 24 and 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1 and 17 recite the limitations “the length” and “the subsequent zone.” There is insufficient antecedent basis for these limitations in the claims.

10. Claim 2 recites the limitation “the intermediate zone.” There is insufficient antecedent basis for this limitation in the claim.

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11. Claim 3 recites the limitation “the zone with the largest entry angle.” There is insufficient antecedent basis for this limitation in the claim.

12. Claim 4 recites the limitation “the zones.” There is insufficient antecedent basis for this limitation in the claim.

13. Claim 5 recites the limitation “the length.” There is insufficient antecedent basis for this limitation in the claim.

14. Claim 6 recites the limitations “the transitions” and “the form of an arc.” There is insufficient antecedent basis for these limitations in the claim.

15. Claim 9 recites the limitations “the total wall thinning,” “the corresponding forming surface,” “the zone running at the largest entry angle” and “the so-called main zone.” There is insufficient antecedent basis for these limitations in the claim.

16. Claim 10 recites the limitations “the total wall thinning,” “the corresponding forming surface” and “the starting zone.” There is insufficient antecedent basis for these limitations in the claim.

17. Claim 11 recites the limitations “the total wall thinning,” “the corresponding forming surface,” “the end zone.” There is insufficient antecedent basis for these limitations in the claim.

18. Claim 12 recites the limitations “the length” and “the starting and/or . . . the end zone.” There is insufficient antecedent basis for these limitations in the claim.

19. Claim 18 recites the limitations “the subsequent zone,” and “the intermediate zone.” There is insufficient antecedent basis for these limitations in the claim.

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20. Claim 19 recites the limitation “the intermediate zone.” There is insufficient antecedent basis for this limitation in the claim.

21. Claim 20 recites the limitation “the zones.” There is insufficient antecedent basis for this limitation in the claim.

22. Claim 22 recites the limitations “the transitions” and “the form of an arc.” There is insufficient antecedent basis for these limitations in the claim.

23. Claim 24 recites the limitation “the starting zone.” There is insufficient antecedent basis for this limitation in the claim.

24. Claim 25 recites the limitation “the end zone.” There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

25. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

26. Claims 1-12 and 17-26, as best understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by McHenry ‘829. McHenry discloses a process and apparatus for wall ironing a product having plastic and metal structure. McHenry discloses, *inter alia*: (1) a wall ironing tool; (2) a forming surface; (3) an entry angle; (4) various zones (inherent), and; (5) a transition that forms an arc (see Figs. 1, 2 and 6).

***Conclusion***

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27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Goetz whose telephone number is 703-308-1411. The examiner can normally be reached on Mon, Tues, Thurs, Fri 7:00am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on 703-308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

29. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3136.

JSG  
May 16, 2003



**ALLEN OSTRAGER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**